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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/733,122

12/11/2003

Takashi Fukaya

17311

7888

23389

7590

10/26/2005

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EXAMINER

NGUYEN, THONG Q

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,122

Applicant(s)

FUKAYA ET AL.

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 15-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/11/03 & 8/22/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the Pre-amendment filed on 12/11/2003 and the Election filed on 8/15/05. It is noted that in the pre-amendment, applicant has amended the specification by adding the information related to the continuation of the present application with respect to the PCT/JP02/111282.

Election/Restrictions

2. Applicant's election of Species (I), illustrated in figures 1-3 and 11-13 in the reply filed on 8/15/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

It is noted that in the Election, applicant has stated that claims 1-7, 9-10, 12-15 and 17-20 readable from the elected species (I). After further review the claims in the light of the present specification, the Examiner respectfully disagrees with the applicant's statement that claims 1-7, 9-10, 12-15 and 17-20 are the claims directed to species (I). The Examiner is of opinion that the claims readable from the species (I) are claims 1-7 and 9-14. The claims directed to species (II) and (III) are readable in claims 8 and 15-23.

In particular, applicant is respectfully invited to review the specification, in particular, in pages 18-35, which discloses the structure of the device as claimed in claims 15-23.

It is noted that a careful search of the device as claimed in independent claim 1 has resulted that the device of claim 1 is patentable with respect to the prior art. Since claim 1 which is generic to the device illustrated in figures 4-7 and claimed in claim 8 is allowable, thus, dependent claim 8 is now rejoined and allowable with its base claim 1. Claims 15-23 are not rejoined because the structure of the device as claimed in claims 15-23 which directed to non-elected species and are different in structure of the device as claimed in claims 1-14.

As a result, claims 1-14 are examined in this Office action, and claims 15-23 have been withdrawn from further consideration as being directed to non-elected species.

3. This application is in condition for allowance except for the presence of claims 15-23 to non-elected species which claims are not rejoined. Applicant should cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter.

Priority

4. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Japan on 11/05/01 and 10/10/02. It is noted, however, that

applicant has not filed a certified copy of the foreign applications as required by 35 U.S.C. 119(b).

Information Disclosure Statement

5. The information disclosure statement filed on 12/11/03 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

6. The drawings contained eight sheets of figures 1-13 were received on 12/11/03. These drawings are approved by the Examiner.

Specification

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

8. Claims 1-2 are objected to because of the following informalities. Appropriate correction is required.

a) In claim 1: on line 6, the feature thereof "the luminous flux" lacks a proper antecedent basis. Should the term "the" in the mentioned feature be changed to --a--? and

b) In claim 2: on line 6, the term "side" should be deleted. See base claim 1, on line 18.

Allowable Subject Matter

9. Claims 1-14 are allowed.

10. The following is an examiner's statement of reasons for allowance:

The surgical microscope as recited in the independent claim 1 is patentable with respect to the cited art, in particular, the Patent Nos. 5,331,457; 4,364,629; and 6,327,079 and the Japanese reference No. 4-355712 by the limitations related to the splitting optical system, the pupil splitting optical system and the second housing supporting the second binocular eyepiece optical system as claimed. It is noted that the use of a housing for supporting a splitting system and a pupil splitting system is disclosed in the art as can be seen in each of the Patent '457 and 629 and the Japanese reference '712; however, the cited art does not disclose a microscope having a splitting system for splitting a light beam into a plurality of light beams having a second light beam, a pupil splitting system for splitting one of the light beam splitted by the splitting system to provide a third light beam, and a second housing supporting an eyepiece rotates from a first rotational angle to a second rotational angle wherein in the first rotational angle, the eyepiece forms an image from the second light beam and in the second rotational angle, the eyepiece forms an image from the third light beam.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

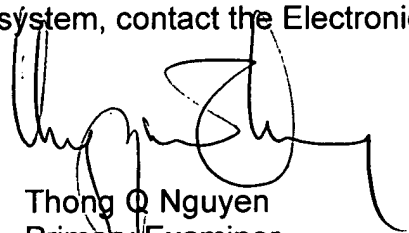
Conclusion

11. The prior art cited in the IDS of 8/22/2005 made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen
Primary Examiner
Art Unit 2872
